OIPE IAP58
DEC 15 2005
PATENT & TRADEMARK OFFICE

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 555255-012190

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on 12/13/2005

Signature Debra L. Pejeau

Typed or printed name Debra L. Pejeau

Application Number	Filed
09/783,726	02/14/2001

First Named Inventor: Mihal Lazaridis

Art Unit	Examiner
2153	Sean M. Reilly

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 39,142
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

David B. Cochran
Signature

David B. Cochran
Typed or printed name

(216) 586-7029
Telephone number

12/13/05
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

OIPE
DEC 15 2005
IAP58
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit:	2153
Examiner:	Reilly, Sean M.
Inventor:	Lazaridis
Serial No.:	09/783,726
Filed:	2/14/2001
For:	System and Method for Pushing. . .
Atty. Docket:	555255-012190

PRE-APPEAL BRIEF REQUEST FOR REVIEW

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited today with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1459 on 12-13-05.

Signature: Debra L. Pejeau

Typed or Printed Name: Debra L. Pejeau

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner finally rejected independent claim 86 under 35 U.S.C. § 103 as being obvious over the combination of three references: (1) AirMobile (Software for Lotus cc:Mail Wireless, Communication Client Guide, Motorola, 1995); (2) Gadol et al. (Nomadic Tenets – A User's Perspective, Sun Microsystems Laboratories, Inc, June 1994); and (3) Eggleston et al. (US 5,764,899) This rejection is now appealed. The Applicant hereby requests review of the final rejection prior to filing an appeal brief for the reasons set forth herein.

REASONS FOR PRE-APPEAL BRIEF CONFERENCE REQUEST

Applicants submits that the final rejection of claim 86 is based upon clear errors in fact and fails to establish a *prima facie* case of obviousness. Claim 86 is the sole independent claim remaining in this application. For purposes of this pre-appeal brief conference request only, applicants limit the argument to this claim.

A. Claim 86 is Patentable Over AirMobile and Gadol and Eggleston

In the final office action, the Examiner stated that the primary reference used in the obviousness rejection, the AirMobile reference, failed to show "using a software interface associated with the messaging server to automatically receive a notification signal when an electronic message is received and stored in the mailbox associated with the wireless mobile communication device." (Office Action, July 27, 2005, at page 3) Moreover, the Examiner found that: "the Applicant has clearly shown on the record. . .that the AirMobile server must internally poll for the arrival on new message in a user's mailbox." (Office Action, July 27, 2005, at page 3)

Turning then to claim 86, which is set forth below, the **highlighted** portions of the claim are those portions that the Examiner has found not to be present in the AirMobile reference:[1]

> 86. A method of replicating electronic messages between a messaging server and a plurality of wireless mobile communication devices using a redirection server program, comprising the steps of:
>
> receiving electronic messages at the messaging server and storing the electronic messages in a message store having a plurality of mailboxes, wherein each of the plurality of wireless mobile communication devices is associated with at least one of the plurality of mailboxes; and
>
> without receiving a request to download the received electronic messages **at the messaging server,** continuously pushing copies of the received electronic messages from the mailboxes associated with each of the wireless mobile

[1] See, Office Action, July 27, 2005, at pages 2-3.

communication devices to the wireless mobile communication devices, wherein the continuously pushing step includes the steps of:

(A) for each of the wireless mobile communication devices, the redirection server program registering with a software interface associated with the messaging server to automatically receive a notification signal when an electronic message is received and stored in the mailbox associated with the wireless mobile communication device;

(B) detecting the received electronic message at the redirection server program by receiving the notification signal from the messaging server's software interface; and

(C) **upon receipt of the notification signal,** the redirection server program accessing the mailbox associated with the wireless mobile communication device and transmitting a copy of the received electronic message to the wireless mobile communication device.

In order to maintain a *prima facie* showing of obviousness, the Examiner must demonstrate where the **highlighted** subject matter of claim 86 is found in one of the secondary references used in the rejection, as this subject matter is admittedly not in the primary reference. (MPEP 2143.03, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka,*490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1980). Although the latest Office Action purports to rely upon the Gadol reference to supply this missing teaching, it is clear that Gadol does not include the **highlighted** subject matter of claim 86.

The Examiner reasoned that Gadol "disclosed an e-mail system where the notification of new message is sent automatically (paging – pg 12, 2nd ¶) as opposed to polling. Gadol further disclosed that automatic notification (paging) is preferable to polling since you get the

notification in real-time (when it happens) (pg 12 2nd ¶)). The entirety of the second paragraph of page 12 of Gadol is set forth below:

> Paging works well for applications such as e-mail. It's preferable to receive an e-mail message when it's sent, rather than have to go to the infrastructure (a post office) to pick it up. This is analogous to receiving a phone call. You simply get it when it happens and you can respond if you're available. Like an answering machine the message is left for later retrieval if you are not *connected* at the time the message is sent.

This portion of the Gadol reference is merely identifying the problem with the prior art polling-based systems, which is that you only get the message when you access the infrastructure. The solution provided in Gadol is to send a paging message when the e-mail is received at the computer system to which the e-mail is addressed, i.e., the destination computer system. This teaching, however, does not provide the missing **highlighted** subject matter from claim 86.

The **highlighted** subject matter from claim 86 that is admittedly missing from the AirMobile reference includes the following: (1) a software interface associated with the message server to generate notification signals when an electronic message is received and stored in the mailbox associated with the wireless communication device; (2) registering with the software interface for each of the wireless mobile communication devices by the redirection server program; and (3) detecting the received electronic message at the redirection server by receiving the notification signal from the software interface.

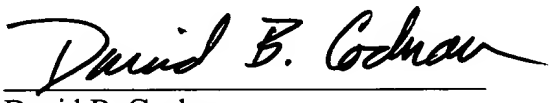
Gadol does not disclose any of these claim elements. Gadol does not teach any type of software interface associated with a messaging server to generate a notification signal when an electronic message is received and stored in a mailbox, Gadol does not teach a redirection server registers with a messaging server's software interface, and Gadol does not teach the detection of new messages by receiving a notification signal at a redirection server. These conclusions are

evident by reading the relied-upon subject matter of Gadol quoted above. Stated succinctly, all Gadol teaches is sending a paging message when an e-mail is received at the destination computer. This minimal teaching of Gadol is insufficient to make up for the admittedly missing teaching from AirMobile as set forth in the **highlighted** claim language, above. Therefore, applicants submit that the Office Action has failed to make out a *prima facie* case of obviousness and thus the rejection of claim 86 should be withdrawn.

The applicants respectfully requests withdrawal of the rejections in light of the aforementioned arguments. It is believed that the application, as now presented, is in condition for allowance and that a Notice of Allowability be issued.

Respectfully submitted,

JONES DAY



David B. Cochran
(Reg. No. 39,142)
Jones Day
North Point, 901 Lakeside Avenue
Cleveland, Ohio 44114
(216) 586-7029